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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/849,239 | 05/07/2001 | Walter R. McVey | 9046-0050 | 8042 |
| 26161 | 7590 | 04/07/2005 | EXAMINER | |
| FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110 | | | CHOI, LING SIU | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1713 | |

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/849,239

Applicant(s)

MCVEY ET AL.

Examiner

Ling-Siu Choi

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 21 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-14 and 21 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 07 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to the Amendment filed January 5, 2005. Claims 15-20 were canceled and claim 21 has been added. Claims 1-14 and 21 are now pending. In view of the Amendment, the claim objections are moved and the rejection of claims 1-14 over Falkner et al. (US 5,789,153) is maintained.

Claim Rejections - 35 USC ' 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-14 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Falkner et al. (US 5,789,153).

The present claims relates to a method to perform electrophoresis comprising

| | |
|-----|---|
| (a) | providing a plurality of sample fragments collectively having a first range of sizes, the sample fragments being tagged with a first number of dyes |
| (b) | providing a plurality of reference fragments collectively having a second range of sizes which does not overlap with the first range of sizes, the reference fragments being tagged with a common dye from among the first |

| | |
|-----|--|
| | number of dyes |
| (c) | combining the sample fragments and the reference fragments into a common volume |
| (d) | causing the sample fragments and the reference fragments within the common volume to separate along a common separation lane such that the sample fragments and the reference fragments are separated from one another in at least one of time and space |
| (e) | optically detecting a fluorescence spectrum comprising a respective fluorescence intensity at each of a plurality of wavelengths from each of the separated sample and reference fragments |
| (f) | determining first color calibration information based upon the fluorescence spectra of reference fragments |
| (g) | determining at least one property of the sample fragments based upon the first color calibration information and the fluorescence spectra of the sample fragments |

(summary of claim 1)

The Rejection is adequately set forth in the paragraph 7 of the previous Office Action and is incorporated herein by reference.

Response to Arguments

4. Applicant's arguments filed on January 5, 2005 have been fully considered but they are not persuasive.

Applicants: To the contrary, one would understand that the peak area of Falkner refers to an area of a gel electrophoresis peak or chromatographic peak rather than to

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the fluorescence intensity at each of a plurality of wavelengths.”

Attention is drawn to claim 2, wherein “...primers in said nucleic acid amplification, said primers containing groups selected from the group consisting of fluorescent groups... and subsequent detection reactions.” Attention is also directed to claim 3, wherein “...further comprising using primers in said nucleic acid amplification, said primers containing fluorescent group.” A conclusion can be drawn that the detection in the disclosure of Falkner et al. is based on the fluorescent signal.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

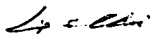
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ling-Siu Choi whose telephone number is 571-272-1098.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reach on 571-272-1114.



LING-SUI CHOI
PRIMARY EXAMINER

April 4, 2005